

Application No.: 09/821341

Case N .: 53628US013

Remarks

Amended claims 37 to 45 are pending.

§ 102 Rejections

Claims 37, 38, 41, 42, and 45 stand rejected under 35 USC § 102(b) as being anticipated by Andrews (U.S. Pat. No. 156,748).

Applicant has amended independent claim 37 to recite within its body a knurl wheel, which comprises a cylindrical body having a rotational axis, including first and second opposed major radial surfaces and an outer peripheral surface between said first and second major surfaces, and each of the first and second surfaces having an undercut portion resulting in a positive rake angle. The knurl wheel also has a plurality of cutting teeth on said outer peripheral surface, said plurality of teeth including a first tooth and a second tooth, and said second tooth being of substantially different configuration from said first tooth. Applicant submits that this amendment clarifies that the claim elements include a knurl wheel. See Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 619-20, 34 USPQ2d 1816, 1819-20 (Fed. Cir. 1995) (“[W]hen the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.”)

Andrews discloses a circular saw blade wherein certain teeth of the saw blade have different lengths. The blade in use is rotated in a clockwise manner, and the leading edge of each tooth is aligned at a different angle (relative to a radial through that tooth) than its trailing edge. The circular saw blade disclosed in Andrews are thus quite different from the knurl wheel invention presented in independent claim 37.

In response to comments in the interview summary of December 19, 2003, Applicant submits one skilled in the art would be able to distinguish between a saw blade and a knurl wheel. The PTO also recognizes the distinction inasmuch as there are separate classifications for knurling, 72/703, and cutting tools, such as saw blades, e.g., 83/851. Applicant invites the Examiner to do a search on an internet search engine, such as www.google.com for the terms “knurl wheel” and “saw blade” to appreciate that the terms have separate meanings in the art and there is no overlap for the

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terms. Accordingly, Andrews does not anticipate the present invention as set forth in amended independent claim 37 (nor its dependent claims 38, 41, 42, or 45).

The rejection of claims 37, 38, 41, 42, and 45 under 35 USC § 102(b) as being anticipated by Andrews (U.S. Pat. No. 156,748) has been overcome and Applicant requests withdrawal of the rejections.

§ 103 Rejections

Claims 39, 40, 43, and 44 stand rejected under 35 USC § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Andrews (U.S. Pat. No. 156,748). These claims are all dependent upon independent claim 37, which recites a knurl wheel which is not disclosed, suggested or made obvious by Andrews. The shapes of the teeth in Andrews and the present invention are substantially different, and those differences stem directly from the different purposes for which tools are designed (sawing vs. knurling). Accordingly, Applicant submits that dependent claims 39, 40, 43, and 44 are not anticipated or made obvious by Andrews.

Claims 39, 40, 43, and 44 each add additional features to claim 37. Claim 37 is patentable for the reasons given above. Thus, claims 39, 40, 43, and 44 are likewise be patentable.

In summary, the rejection of claims 39, 40, 43, and 44 under 35 USC § 103(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Andrews (U.S. Pat. No. 156,748), has been overcome and Applicant requests withdrawal of the rejections.

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Conclusion

In view of the above, it is submitted that the application is in condition for allowance.
Reconsideration of the application is requested.

Allowance of claims 37-45, as amended, at an early date is solicited.

Respectfully submitted,

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Date

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